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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92050734
Party	Plaintiff Real Estate Channel Corporation
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Date	12/21/2009
Attachments	Reply in Support of Motion for Summary Judgment.pdf (7 pages)(158775 bytes) Exhibit A.pdf (13 pages)(52176 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

REAL ESTATE CHANNEL
CORPORATION,

Petitioner,

v.

IV-MEDIA LLC.,

Registrant.

Cancellation No. 92/050,734

Registration No. 3,270,964

Mark: THEREALESTATECHANNEL

**REPLY MEMORANDUM IN SUPPORT OF PETITIONER’S MOTION FOR
SUMMARY JUDGMENT AND MEMORANDUM IN OPPOSITION TO
REGISTRANT’S CROSS-MOTION FOR SUMMARY JUDGMENT ON COUNT I**

Petitioner, Real Estate Channel Corporation, through its attorneys, has respectfully moved this Board for Summary Judgment. The testimony period has not opened, suspended discovery has yet to close. Petitioner states as follows:

A. REAL ESTATE CHANNEL and THEREALESTATECHANNEL are Identical Marks and Filing One with Actual Knowledge of the Existence of the Other is Fraud

1. Examiner Kon Agrees These Marks are Legal Equivalents

On June 18, 2009, Examining Attorney Elissa Garber Kon of Law Office 106 issued a refusal to register the refiled REAL ESTATE CHANNEL based on Section 2(d) as likely to be confused with THEREALESTATECHANNEL and based on Section 2(e)(1) based on a finding the mark is merely descriptive (see 6/18/09 Office Action attached as Exhibit A). Examining Attorney Kon compared both marks at issue in this case.

With regard to the 2(d) rejection, the Examiner wrote, “Here, the marks of the parties are identical.” The Examiner explained that the three spaces and the word “THE” are insufficient to alter the mark in any substantial fashion. The Examiner then compared Registrant’s services to Petitioner’s services and concluded with equal conviction, “The services of the parties are also identical ... In essence, both the applicant and registrant provide real estate information” (see Exhibit A).

With regard to the 2(e)(1) rejection, the Examiner wrote, “The proposed mark [REAL ESTATE CHANNEL] is merely descriptive of the services because it immediately tells consumers that the real estate-related services (such as real estate information services) are available via a channel through broadcasting or other means of listing channels” (see Exhibit A). As demonstrated earlier, Examining Attorney Kon is only the latest of a long list of examiners who share this position.

2. *Lemuel E. Lewis Does Not Use THEREALESTATECHANNEL*

Of great interest is para. 26 of the Sworn Declaration of Mr. Lemuel E. Lewis. This paragraph reads, “That separate webpage listing ‘The RealEstate Channel’ mark consistently has been available on websites operated by IV-Media, LLC since December 26, 1997” (see para. 26 of the Lemuel E. Lewis Declaration attached as Exhibit E to the Response). The spelling of the mark in the declaration is of great interest. Petitioner asks this Board to note how the mark is used in commerce, not as the mark as filed. Spaces are inserted in the mark shown in the declaration between the words “the” and “realestate” and between “realestate” and “channel.” When the webpages attached as Exhibit 10 to the Response are also viewed, they all use the mark THE REALESTATE CHANNEL. Further, if these printouts are to be trusted, the mark was displayed with a registration symbol years before the registration had been obtained.

Petitioner is left to wonder why Registrant would (a) uncover during a search the mark REAL ESTATE CHANNEL, (b) file for the mark THEREALESTATECHANNEL, and then (c) use the mark THE REALESTATE CHANNEL. Why didn’t Registrant apply for THE REALESTATE CHANNEL if that was the mark used in commerce.

B. The Subjective Intent of Mr. Lewis is Irrelevant

This case has not reached the testimony period where Petitioner can question the veracity of the declaration of Mr. Lewis. In this early stage on Summary Judgment, the statement must be assumed accurate. There is no point in Applicant responding to the allegations of use, of intent, and of first use. *In re Bose* provides: “The Board stated in *Medinol v. Neuro Vasx, Inc.* that to determine whether a trademark registration was obtained fraudulently, “[t]he appropriate inquiry is ... not into the registrant’s subjective intent, but rather into the objective manifestations of that intent. We agree.” *In re Bose Corp.*, 91 USPQ2d 1938 (Fed. Cir. 2009) citing *Medinol v. Neuro Vasx, Inc.*, 67 USPQ2d 1205, 1209 (TTAB 2003). Registrant’s self-serving declaration is irrelevant; only the objective manifestation before this Office counts. In the declaration,

Registrant swears that it was not his subjective intent to mislead the Office into obtaining the registration. Subjective intent declarations cannot be given any weight; after all based on the principle that any person capable of fraud in the first place will have no problem filing any needed declaration. This Board must look into the objective manifestations of the intent at the time of filing as supported by facts. The facts are clear in this case.

C. Actions Taken Outside of Filing Are Irrelevant

Registrant provides evidence of use of a different mark, namely “THE REALESTATE CHANNEL,” with a registration symbol in different time periods in an effort to prove the good faith filing basis of Mr. Lewis at filing. This Board must look at the objective manifestations of the intent at the time of filing of the registration up for cancellation. Registrant confirms the uncontested fact is that on May 21, 2002, U.S. Reg. U.S. Reg. 2,572,275 was registered to Petitioner (see para. D of Registrant’s Response) and was cancelled on February 28, 2009 (see para. G of Registrant’s Response), years after the filing of the Registration on review. Registrant admits Petitioner’s mark was alive and valid as of the filing date of THEREALESTATECHANNEL. Further, Registrant has admitted actual knowledge of Petitioner’s mark on the Registry at the time of filing. Registrant admits using THE REALESTATE CHANNEL, as he filed for a different mark while the mark REAL ESTATE CHANNEL was already registered. Further, there was no need to file the mark under 2(f) if in fact Registrant was convinced the mark differed from the Petitioner’s mark and that Registrant’s mark was not descriptive. Yet an unsolicited 2(f) claim of exclusive use was made. Clear and convincing evidence is found from the records at the Office. THEREALESTATECHANNEL is descriptive, had a legal equivalent on file as of the day of filing. Issuance of Registrant’s mark is a clear mistake by the Office. Petitioner should not suffer extensive and long litigation and summary judgment must be granted to correct the mistake.

D. In re Bose Cannot Be Carte Blanche to Deceive

In *In re Bose* and *Medinol*, marks were renewed without proper verification that all of the goods in the recitation were still in use. The *Medinol* result was harsh in that the entire registration was cancelled for failing to conduct an investigation as to one of the numerous goods on the recitation of goods. The Office to operate must rely on truthful statements by applicants. These statements are the cornerstone of the prosecution in trademark law. Half truths on statements must not be tolerated.

In 2006, Registrant conducted a search, found an identical mark on the Registry, made immaterial changes to the mark, changes that are visibly not even used by Registrant, and made a unsolicited declaration under 2(f) of continuous and exclusive use in an effort to obtain allowance. Because of an Office mistake, or most likely because of removal of spaces in the mark which may have confused searching tools of the Office, the mark wrongfully issued. At the time of filing, Petitioner's mark was alive. It had been registered for at least five years. Several examiners, including Examiner Kon in 2009, agree that Registrant's mark is identical to Petitioner's mark when Registrant filed and is descriptive absent a showing of secondary meaning. Few cases before this Office will ever benefit from this level of objective evidence to support a finding of fraud. The actions of the Registrant are clear; objective intent is clear and convincing evidence is in the record.

Petitioner can only imagine the chilling effects of finding against Petitioner:

Question from client to counsel: "That can't be good, your search uncovered the mark I want. What can I do?"

Attorney: "Let's change a letter in the mark and put in a pronoun. That makes it hard to catch during the search. With some luck, it will go through."

Client: "But that's still the same mark, isn't it? Do I have to use the mark as you propose? That's not how I use my mark."

Attorney: "Not really. I have a case here where the Examiner missed a conflicting mark during his search because spaces were removed. It issued, and the conclusion was, short of you admitting on the record you intended to lie when you filed, nothing will cancel the mark."

Client: "Will they know we did this search? Do I have to make statements? Here I say I am using it exclusively, but clearly these people must be using it, since they got this years ago."

Attorney: "Just don't look it up."

Petitioner apologizes for the humorous tone of this hypothetical scenario. It is not meant in disrespect to Registrant but simply to illustrate how fraud will become a thing of the past unless objective intent is relied upon at this early stage. The Trademark Office does not ask applicants about search results but instead must rely on the veracity of statements. When an applicant knows the identical mark is registered yet makes a declaration of exclusive use, the Office must find intent to deceive.

E. Registrant's Cross-Motion Should Be Denied

Motions for summary judgment in cancellation cases should be filed before the commencement of the first testimony period. 37 CFR § 2.127(e)(1). Summary judgment is appropriate when the pleadings, affidavits, and other summary judgment evidence show that no

genuine issue of material fact exists and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c); *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986). The moving party, which here is Registrant, bears the burden of identifying those portions of the record it believes demonstrate the absence of a genuine issue of material fact. *Celotex*, 477 U.S. at 322-25. Mere speculation, self-interested assertions, and conclusory allegations are insufficient. *Mills v. First Federal Sav. & Loan Ass'n*, 83 F.3d 833, 840-41 (7th Cir. 1996); *Palucki v. Sears, Roebuck & Co.*, 879 F.2d 1568, 1572 (7th Cir. 1989); *Dale v. Chicago Tribune Co.*, 797 F.2d 458, 464 (7th Cir. 1986), *cert. denied*, 479 U.S. 1066 (1987).

Here, Registrant moves for Summary Judgment on Count I stating in a very broad conclusion that Petitioner cannot and will never be able to meet its heightened burden of proving fraud under the standard outlined by the Court of Appeals for the Federal Circuit in *In re Bose*. Registrant must show that even if all of Petitioner's assertions as pled are shown to be true during discovery and testimony, the Count must still be dismissed. *In re Bose* does not stand for the proposition that failure to win summary judgment on fraud equals the incapacity to win on the Brief of the Case on Fraud. Therefore, the cross-motion for Summary Judgment cannot be granted.

F. Conclusion

Immediately after learning about the existence of Registrant's mark, Petitioner refiled for its abandoned mark and petitioned for cancellation of Registrant's mark. Petitioner knew the Examiner would raise Registrant's mark against the new mark. Examining Attorney Kon has rightfully rejected the mark under §§ 2(d) and 2(e)(1). The right venue for Petitioner is before this Board. Several Examining Attorneys agree that Petitioner's mark is identical or a legal equivalent to Registrant's mark. Who can imagine providing Internet-based information without dynamic links, a mechanism at the heart of web browsing.

Uncontested evidence shows that days before the filing, Registrant conducted a search and uncovered an identical registered mark in full force. The mark was on the Supplemental Register. Registrant modified the mark slightly, filed for a different mark than what was used, and obtained allowance. Anticipating a § 2(e)(1) rejection, Registrant even volunteered a 2(f) statement claiming continuous and exclusive use. The subjective intent of Registrant is immaterial. Registrant admits actual knowledge of Petitioner's mark yet a claim of exclusive use

was entered. This Board must send a clear signal that intent to mislead is objectively found when a person has knowledge of an identical mark, yet claims exclusive use.

WHEREFORE, Petitioner respectfully requests the Board grant its Motion for Summary Judgment as to one or more of the two counts in the Petition to Cancel.

Respectfully submitted,

REAL ESTATE CHANNEL CORPORATION

Dated: December 21, 2009

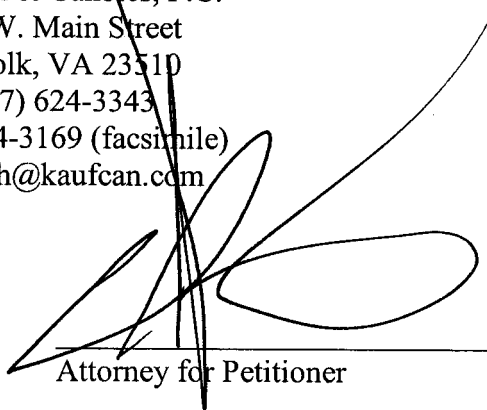
/Alain Villeneuve/
Alain Villeneuve

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CERTIFICATE OF SERVICE

I hereby certify that on the 21st day of December 2009, I served a true and correct copy of the foregoing **Reply Memorandum in Support of Petitioner's Motion for Summary Judgment and Memorandum in Opposition to Registrant's Cross-Motion for Summary Judgment on Count I** on the attorney for the Petitioner at the address indicated below by depositing said document in the United States mail, first class postage prepaid:

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Attorney for Petitioner

To: Real Estate Channel Corporation (avilleneuve@vedderprice.com)

Subject: U.S. TRADEMARK APPLICATION NO. 77694514 - REAL ESTATE CHANNEL - 41622.00.000

Sent: 6/18/2009 2:43:28 PM

Sent As: ECOM106@USPTO.GOV

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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/694514

MARK: REAL ESTATE CHANNEL

CORRESPONDENT ADDRESS:

ALAIN VILLENEUVE
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222 N LASALLE ST STE 2600
CHICAGO, IL 60601-1104

77694514

RESPOND TO THIS ACTION:

<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Real Estate Channel
Corporation

**CORRESPONDENT'S
REFERENCE/DOCKET NO:**

41622.00.000

CORRESPONDENT E-MAIL ADDRESS:

avilleneuve@vedderprice.com

OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 6/18/2009

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62, 2.65(a); TMEP §§711, 718.03.

SECTION 2(d) REFUSAL: LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 3270964. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. The marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). The goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001); TMEP §§1207.01, 1207.01(a)(vi).

The Marks at Issue

The applicant seeks to register REAL ESTATE CHANNEL in connection with providing a variety of real estate-related information, such as in the field of home listings, how to set and negotiate prices, preparing to show a home, mortgage lending, closings, appraisals, and all information, content and services relating to the real estate industry available via various media.

The registered mark is: THEREALESTATECHANNEL for providing information in the field of real estate by means of linking the website to other websites featuring real estate information.

Comparison of the Marks

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP §1207.01(b).

If the marks of the respective parties are identical, the relationship between the goods and/or services of the respective parties need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks. *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *Amtcor, Inc. v. Amtcor Indus., Inc.*, 210 USPQ 70, 78 (TTAB 1981); TMEP §1207.01(a).

Here, the marks of the parties are identical. The only differences are that the applicant's mark is three separate words, while the registrant's mark is pushed together as one word, and the registrant's mark contains the non-descript word THE, which lends no trademark significance.

The term "the" is not distinctive and does not add any source-identifying significance. *See, e.g., In re The Place, Inc.*, 76 USPQ2d 1467, 1468 (TTAB 2005) (holding THE GREATEST BAR merely descriptive for restaurant and bar services); *In re Weather Channel, Inc.*, 229 USPQ 854, 856 (TTAB 1985) (holding THE WEATHER CHANNEL merely descriptive for weather information services and television programming relating to weather); *In re The Computer Store, Inc.*, 211 USPQ 72, 74-75 (TTAB 1981) (holding THE COMPUTER STORE merely descriptive for retail outlets featuring computers).

Comparison of the Goods/Services

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

If the goods and/or services of the respective parties are "similar in kind and/or closely related," the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as would be required with diverse goods and/or services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *see Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350,

1354 (Fed. Cir. 2004); TMEP §1207.01(b).

The services of the parties are also identical. The applicant's description of services is overly broad and encompasses providing real estate information and "all information, content, services, broadcasting, programming and other commercial transactions relating to the real estate industry." The registrant's services include providing information in the field of real estate by linking users to web sites of others featuring real estate information. In essence, both the applicant and registrant provide real estate information.

Based on the foregoing, registration is refused under Section 2(d) of the Trademark Act.

REFUSAL: THE PROPOSED MARK IS MERELY DESCRIPTIVE OF THE SERVICES

In addition to the foregoing, registration is refused because the applied-for mark merely describes a feature of applicant's services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods and/or services. TMEP §1209.01(b); *see In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Gyulay*, 820 F.2d 1216, 1217-18, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987). Moreover, a mark that identifies a group of users to whom an applicant directs its goods and/or services is also merely descriptive. TMEP §1209.03(i); *see In re Planalytics, Inc.*, 70 USPQ2d 1453, 1454 (TTAB 2004).

The determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978); TMEP §1209.01(b); *see, e.g., In re Polo Int'l Inc.*, 51 USPQ2d 1061 (TTAB 1999) (finding DOC in DOC-CONTROL would be understood to refer to the "documents" managed by applicant's software, not "doctor" as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (finding CONCURRENT PC-DOS merely descriptive of "computer programs recorded on disk" where relevant trade used the denomination "concurrent" as a descriptor of a particular type of operating system). "Whether consumers could guess what the product is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

In this case, the applicant seeks to register REAL ESTATE CHANNEL in connection with real estate information services, broadcasting, programming and a "other commercial transactions relating to the real estate industry that are available via various media." The proposed mark is merely descriptive of the services because it immediately tells consumers that the real estate-related services (such as real estate information services) are available via a channel through broadcasting or other means of using channels.

A mark that combines descriptive words may be registrable if the composite creates a unitary mark with

a separate, nondescriptive meaning. *In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968) (holding SUGAR & SPICE not merely descriptive of bakery products because of the mark's immediate association with the nursery rhyme "sugar and spice and everything nice"). However, the mere combination of descriptive words does not automatically create a new nondescriptive word or phrase. *See, e.g., In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1662 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely descriptive for theater ticket sales services).

The registrability of a mark created by combining only descriptive words depends on whether a new and different commercial impression is created, and/or the mark created imparts an incongruous meaning as used in connection with the goods and/or services. TMEP §1209.03(d); *e.g., In re Copytele, Inc.*, 31 USPQ2d 1540, 1542 (TTAB 1994); *In re Associated Theatre Clubs*, 9 USPQ2d at 1662. Where, as in this case, the combination of the descriptive words creates no incongruity, and no imagination is required to understand the nature of the goods and/or services, the mark is merely descriptive.

The proposed mark is simply a combination of the descriptive terms REAL ESTATE and CHANNEL. REAL ESTATE is defined as: property in buildings and land. CHANNEL is defined as a means of communication or expression: as (1): a path along which information (as data or music) in the form of an electrical signal passes. *See attached definitions*. Taken together, the proposed mark tells consumers that the applicant's real estate information services are available via an electronic channel. The combination of these descriptive terms does not create a mark whose commercial impression is greater than the mere sum of its descriptive component terms.

Note that CHANNEL is generic for broadcasting services, entertainment services in the form of programs, programming and channels or stations, and for other services available via electronic means. The examining attorney has attached several sample registrations from the Office's database of registered marks wherein CHANNEL was disclaimed on the Supplemental Register for these and other related services.

Based on the foregoing, registration on the Principal Register must be refused under Trademark Act Section 2(e)(1).

Note that the current description of services is vague and overly broad. Depending on the amended description of services, the examining attorney may require a disclaimer of generic wording, or may even refuse registration if the mark is generic for the named services.

Supplemental Register Advisory

If filed under Section 1(a): The applied-for mark has been refused registration on the Principal Register. Applicant may respond to the refusal by submitting evidence and arguments in support of registration and/or by amending the application to seek registration on the Supplemental Register. *See*

15 U.S.C. §1091; 37 C.F.R. §§2.47, 2.75(a); TMEP §§801.02(b), 816. Amending to the Supplemental Register does not preclude applicant from submitting evidence and arguments against the refusal(s).

If filed under Section 1(b): A mark in an application under Trademark Act Section 1(b) is not eligible for registration on the Supplemental Register until an acceptable amendment to allege use under 37 C.F.R. §2.76 has been filed. 37 C.F.R. §§2.47(d), 2.75(b); TMEP §§815.02, 1102.03. When a Section 1(b) application is successfully amended to the Supplemental Register, the effective filing date of the application will be the date on which applicant met the minimum filing requirements of 37 C.F.R. §2.76(e) for the amendment to allege use. 37 C.F.R. §2.75(b); TMEP §§816.02, 1102.03.

ADDITIONAL REQUIREMENTS

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration. Applicant must respond to the requirement(s) set forth below.

DESCRIPTION OF SERVICES

The wording referenced below in the identification of services is indefinite and must be clarified because it is vague and in some cases, includes services that belong in more than the listed classes. *See* TMEP §1402.01. Applicant must amend this wording to specify the common commercial or generic name for the services. If there is no common commercial or generic name for the services, then applicant must describe the nature of the services as well as their main purpose, channels of trade, and the intended consumer(s).

Information services are classified according to the classification of their content. Real estate information is in Class 36. Real estate appraisal and mortgage lending information are in Class 36. Real estate home staging information belongs in Class 42, while information about real estate closings belongs in Class 45. Placing the wording "real estate services" in front of the different services does not place them into Class 36, as real estate-related services are classified in various different classes.

The applicant must amend "all information, content, services, broadcasting, programming and other commercial transactions relating to the real estate industry..." to name each service by its common, generic name and classify it accordingly. Some examples of acceptable wording appear below.

The applicant may amend to any or all of the following, if accurate:

Class 35: providing information to buyers and sellers of real estate in the field of

how to set and negotiate the prices of real estate

Class 36: providing information to buyers and sellers of real estate in the fields of home listings, mortgage lenders, appraisal services and showing homes for sale

Class 38: entertainment in the nature of an ongoing television show in the field of real estate, broadcast over television, satellite, audio and video media

Class 42: providing information to buyers and sellers of real estate in the field of home staging involving how to prepare a home for sale

Class 45: providing information to buyers and sellers of real estate in the field of the real estate closing process

Applicant may amend the identification to list only those items that are within the scope of the goods set forth in the application or within the scope of a previously accepted amendment to the identification. *See* 37 C.F.R. §2.71(a); TMEP §§1402.06 *et seq.*, 1402.07.

The applicant is advised that the above suggestions may not be a complete listing of acceptable specifications available to the applicant, but are instead provided only as suggestions. It is the applicant's duty to properly identify and classify the goods and services. TMEP Section 1402.01(e).

For assistance with identifying and classifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netahtml/tidm.html>. *See* TMEP §1402.04.

Please also note that the applicant may not use the indefinite wording “and/or,” “or,” or “etc.” in its identification of goods/services. The applicant must use the more definite word “and” when listing more than one item. The applicant may not use parentheticals in its description of goods/services. The examining attorney may have used them above merely to indicate wording that requires further amendment.

MULTI-CLASS FILING RULES

The application identifies goods and/or services that are classified in at least two classes; however, the fees submitted are sufficient for only one class(es). In a multiple-class application, a fee for each class is required. 37 C.F.R. §2.86(a)(2); TMEP §§810.01, 1403.01.

Therefore, applicant must either (1) restrict the application to the number of classes covered by the fee(s) already paid, or (2) submit the fees for the additional class(es).

If applicant prosecutes this application as a combined, or multiple-class application, then applicant must comply with each of the requirements below for those goods and/or services based on actual use in commerce under Trademark Act Section 1(a):

- (1) Applicant must list the goods/services by international class;
- (2) Applicant must submit a filing fee for each international class of goods and/or services not covered by the fee already paid (current fee information should be confirmed at <http://www.uspto.gov>); and
- (3) For each additional international class of goods and/or services, applicant must submit:
 - (a) Dates of first use of the mark anywhere and dates of first use of the mark in commerce, or a statement that the dates of use in the initial application apply to that class. The dates of use, both anywhere and in commerce, must be at least as early as the filing date of the application.;
 - (b) One specimen showing the mark in use in commerce for each class of goods and/or services. The specimen must have been in use in commerce at least as early as the filing date of the application. If a single specimen supports multiple classes, applicant should indicate which classes the specimen supports rather than providing multiple copies of the same specimen. Examples of specimens for goods are tags, labels, instruction manuals, containers, photographs that show the mark on the goods or packaging, or displays associated with the goods at their point of sale. TMEP §§904.03 *et seq.* Examples of specimens for services are signs, photographs, brochures, website printouts or advertisements that show the mark used in the sale or advertising of the services. TMEP §§1301.04 *et seq.*;
 - (c) The following statement: **“The specimen was in use in commerce on or in connection with the goods and/or services listed in the application at least as early as the filing date of the application.”**; and
 - (d) Verification of the statements in 3(a) and 3(c) (above) in an affidavit or a signed declaration under 37 C.F.R. §§2.20, 2.33. Verification is not required where (1) the dates of use for the added class are stated to be the same as the dates of use specified in the initial application, and (2) the original specimens are acceptable for the added class(es).

See 15 U.S.C. §§1051(a), 1112, 1127; 37 C.F.R. §§2.32(a)(5), 2.34(a)(1), 2.56(a), 2.71(c), 2.86(a); TMEP §§1403.01, 1403.02(c).

With respect to the requirement in 3(b) above for a specimen for each class of goods and/or services, please note that the specimen(s) of record is acceptable for International Class(es) 35, 36, 42 and 45 only. Applicant must submit additional specimens if other classes are added to the application.

If applicant prosecutes this application as a combined, or multiple-class application, then applicant must

comply with each of the following for those goods and/or services based on an intent to use the mark in commerce under Trademark Act Section 1(b) :

- (1) Applicant must list the goods and/or services by international class; and
- (2) Applicant must submit a filing fee for each international class of goods and/or services not covered by the fee already paid (current fee information should be confirmed at <http://www.uspto.gov>).

See 15 U.S.C. §§1051(b), 1112, 1126(e); 37 C.F.R. §§2.34(a)(2)-(3), 2.86(a); TMEP §§1403.01, 1403.02(c).

Fees

The filing fee for adding classes to an application is as follows:

(1) \$325 per class, when the fees are submitted with a response filed online via the Trademark Electronic Application System (TEAS) at <http://www.uspto.gov/teas/index.html>; or

(2) \$375 per class, when the fees are submitted with a paper response.

37 C.F.R. §2.6(a)(1)(i)-(a)(1)(ii); TMEP §810.

SPECIMEN

If the applicant amends the description of services to include Class 38, or other additional classes, then the applicant must comply with the following.

The specimen is not acceptable because it does not show the applied-for mark in use in commerce. An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use in commerce for each class of services. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

The specimen consists of an advertising brochure for various real estate services and is not acceptable as evidence of actual service mark use for Class 38 because it does not show the mark used to promote a show about real estate. Thus, it fails to show proper use of the applied-for mark in the sale or advertising of the services.

Therefore, applicant must submit the following:

- (1) A substitute specimen showing the mark in use in commerce for each class of services specified in the application; and
- (2) The following statement, verified with an affidavit or signed declaration under 37 C.F.R. §§2.20, 2.33: **‘The substitute specimen was in use in commerce at least as early as the filing**

date of the application.” 37 C.F.R. §2.59(a); TMEP §904.05. If submitting a substitute specimen requires an amendment to the dates of use, applicant must also verify the amended dates. 37 C.F.R. §2.71(c); TMEP §904.05.

Examples of specimens for services are signs, photographs, brochures, website printouts or advertisements that show the mark used in the actual sale or advertising of the services. *See* TMEP §§1301.04 *et seq.*

If applicant cannot satisfy the above requirements, applicant may amend the application from a use in commerce basis under Section 1(a) to an intent to use basis under Section 1(b), for which no specimen is required. *See* TMEP §806.03(c). However, if applicant amends the basis to Section 1(b), registration will not be granted until applicant later amends the application back to use in commerce by filing an acceptable allegation of use with a proper specimen. *See* 15 U.S.C. §1051(c), (d); 37 C.F.R. §§2.76, 2.88; TMEP §1103.

To amend to Section 1(b), applicant must submit the following statement, verified with an affidavit or signed declaration under 37 C.F.R. §§2.20, 2.33: **“Applicant has had a bona fide intention to use the mark in commerce on or in connection with the services listed in the application as of the filing date of the application.”** 37 C.F.R. §2.34(a)(2); TMEP §806.01(b); *see* 15 U.S.C. §1051(b); 37 C.F.R. §2.35(b)(1).

Pending receipt of a proper response, registration is refused because the specimen does not show the applied-for mark in use in commerce as a service mark. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

DECLARATION

The following is a properly worded declaration under 37 C.F.R. §2.20. Applicant should add this declaration to the end of its response, properly signed and dated by a person authorized under 37 C.F.R. §2.33(a). TMEP §804.01(b).

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that: **The substitute specimen was in use in commerce at least as early as the filing date of the application and/or Applicant has had a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application as of the filing date of the application;** all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

(Signature)

(Print or Type Name and Position)

(Date)

NOTE: APPLICABLE LEGAL AUTHORITIES

The following legal authorities govern the processing of trademark and service mark applications by the Office: The Trademark Act of 1946, 15 U.S.C. §§1051 *et seq.*; The Trademark Rules of Practice, 37 C.F.R. Part 2; and the Office's *Trademark Manual of Examining Procedure* (TMEP) (5th ed. 2007). These legal resources are available online at <http://www.uspto.gov/main/trademarks.htm>.

“TMEP” refers to the Office's *Trademark Manual of Examining Procedure* (5th ed. 2007), available on the United States Patent and Trademark Office website at www.uspto.gov/main/trademarks.htm. The TMEP is a detailed administrative manual written by the Office to explain the laws and procedures that govern the trademark/service mark application, registration and post registration processes.

The Trademark Applications and Registrations Retrieval (TARR) database on the USPTO website at <http://tarr.uspto.gov> provides detailed, up to the minute information about the status and prosecution history of trademark/service mark applications and registrations. To access the TARR database, applicant will need to provide an application serial number or registration number.. The TARR database is available 24 hours a day, 7 days a week.

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RESPOND TO THIS ACTION: Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial

filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.